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In re Application of:
BOSKAMP, EDDY B.
Serial No. 10/063,550
Filed: May 2, 2002
Docket: GEMS8081.091
Title: WIRELESS RF MODULE FOR AN MR
IMAGING SYSTEM

2/13/09

DECISION ON PETITION

This is a decision on the renewed petition filed on October 3, 2008. Petitioner is requesting to withdraw the holding of abandonment and to withdraw the holding of a non-compliant appeal brief. This petition is being considered pursuant to 37 CFR 1.181. No fee is required under this section.

The petition is DENIED.

The relevant portion of the record shows that:

1. A final rejection was mailed on February 23, 2005 rejecting claims 1-8 and 10-28 as amended on March 15, 2004.
2. In response to the final rejection, on April 25, 2005, the applicant filed an amendment after final with substantive amendment to claims 17 and 21 and mislabeled the claims status for claims 5, 19 and 25.
3. The examiner issued an advisory action on May 19, 2005, informing the applicant that the amendment after final filed on April 25, 2005 will not be entered because the amendment does not place the application in better form for appeal.
4. On June 23, 2005, the applicant filed another amendment after final representing the same substantive amendment to claims 17 and 21, canceling claim 9, and again mislabeled claims status after claims 5 and 25, and argued that the amendment after final should be entered because the amendment to claim 17 would remove the rejection under 35 USC § 101/112. A Notice of Appeal was also filed on June 23, 2005.

5. On August 17, 2005, the applicant filed a third amendment after final. In the accompanying remarks, the applicant alleged that there was a telephone conversation between the applicant's attorney and the examiner on August 17, 2005. The applicant stated that "the examiner indicated to the applicant's attorney that the amendments of the after-final Amendment/Response to Office Action mailed February 23, 2005 (and represented in the Response to Advisory Action mailed May 19, 2005 and Request for Reconsideration) could not be entered because of informalities with respect to claims 5, 19, and 25. With the amendments herein (which include a representation of the amendments presented in the After-Final Amendment), Applicant believes the claims are now in condition for appeal. Specially, claims 5 and 19 have been cancelled and represented in new claims 29 and 30, respectively. The status of claim 25 has been changed from "new" to "previously presented". However, the record does not show a record of the telephone conversation. No telephone summary form was completed by the examiner.
6. On August 23, 2005, the applicant filed an appeal brief based on the claims submitted in the amendment after final of August 17, 2005.
7. A Notification of Non-Compliant Appeal Brief was mailed on November 2, 2005. In the Notification, the examiner stated that the Appeal Brief was defective and that the after final amendment of August 17, 2005 contains new material not presented in previous claims. The claim also introduced new element, UHF carrier frequency signal. Therefore, the amendment was not entered. The applicant was notified that the amendment after final filed on August 17, 2005 will not be entered.
8. A Response to Notification of Non-Compliant Appeal Brief was filed on December 1, 2005. In this response, the applicant asserted that the examiner and the applicant had a telephone conversation and agreed that the August 17, 2005 amendment after final Rejection would be entered for appeal purpose. In the response, the applicant again stated that "...in the Telephone Interview, the undersigned verbally conveyed the proposed amendments to the Examiner. The Examiner stated that there would not be any issue with respect to the entry of the proposed amendments and acknowledged that the amendments would overcome the informalities and place the application in condition for appeal. As such, Applicant filed the After-Final Amendment of August 17, 2005 amending the claims as proposed to the Examiner to address the informalities raised by the Examiner and place the application in condition for appeal."
9. The notice of abandonment was mailed on November 21, 2007 due to the applicant's failure to timely file an amended brief or other appropriate correction in response to the November 2, 2005 Notification of Non-Compliant Appeal Brief.
10. A petition was filed on January 17, 2008. The petitioner requests withdrawal of the abandonment as well as withdrawal of the November 2, 2005 Notification of Non-Compliant Appeal Brief. The petition was dismissed on August 5, 2008.
11. Current renewed petition for reconsideration of the previous decision mailed August 5, 2008 was filed on October 3, 2008.

Analysis and Discussion

After a study of the entire file, there is simply no record which indicates that there was any verbal agreement between the examiner and the applicant's attorney regarding the amendment after final filed on August 17, 2005. Moreover, a review of the after final amendment of August 17, 2005 clearly shows that the amendment does not comply with 37 CFR 1.116 because at least claims 17 and 21 were substantively amended in the same manner as in the previously filed after final amendment which was denied. The newly amended claim 17 was broadened from the claim 17 under final rejection. The applicant removed a limitation regarding "batteryless means for powering the means for wirelessly transmitting" and added a new limitation "with a UHF carrier frequency signal" which were never considered in the final rejection of claim 17. The added limitation in the newly amended claim 21 was never addressed in the final rejection of Feb. 23, 2005. Therefore, a prudent examiner would not have entered this amendment for appeal purpose. Furthermore, there was no written proposed amendment presented to the examiner prior or during the alleged telephone conversation between the examiner and the applicant's attorney on August 17, 2005 as indicated by the applicant's attorney in his telephone record of August 17, 2005 (see page 2, second paragraph of the response filed on December 1, 2005). Under 37 C.F.R. § 1.2, business must be transacted in writing.¹ In absence of any written record that the examiner has expressly agreed to enter the verbally proposed amendment of August 17, 2005, this amendment will not be entered as stated in the Notification of Non-Compliant Appeal Brief of November 2, 2005. The ensuing Appeal Brief filed on August 23, 2005 remains defective.

After receiving the November 2, 2005 Notification of Non-Compliant Appeal Brief, the applicant failed to file a proper response in accordance with MPEP 1205.03.² Accordingly, the application was abandoned.

Conclusion

For the reasons stated above, the request to enter the amendment after final under Rule 116 and withdrawal of the holding of non-compliant appeal brief will not be granted. The relief requested is denied.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR

¹ 37 C.F.R. 1.2 states:

All business with the Patent and Trademark Office Should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

² MPEP 1205.03, second paragraph, states:

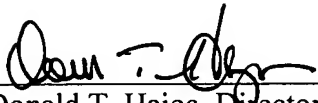
Under 37 CFR 41.37(d), the appellant may file an amended brief to correct the deficiencies in the original brief. Moreover, if appellant disagrees with the holding of noncompliance, a petition under 37 CFR 1.181 or 41.3 may be filed. Filing a petition will not toll the time period. Appellant must timely reply to the notice or the Office communication that requires an amended brief.

1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

A petition to revive under 37 CFR § 1.137, including the required fee and a compliant brief, should be separately filed and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner at (571) 272-4856.

Accordingly, the petition is **denied**.



Donald T. Hajec, Director
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